

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Awdhoot Vasant Kerkar, et al.
Serial No : 10/812,541
Filed : March 30, 2004
For : ROOFING SHINGLES PROVIDED WITH RELEASE
COATING
Examiner : Alicia Ann Chevalier
Art Unit : 1794
Docket : FDN 2831 (040001U034)
Dated : March 5, 2009

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF IN REPLY TO EXAMINER'S ANSWER

This Brief is being filed in Reply to the Examiner's Answer mailed January 5, 2009, and further to Appellants Appeal Brief filed October 14, 2008 ("Appeal Brief"). Appellants respectfully request reconsideration and reversal of the rejections of the Final Office Action mailed July 25, 2007 ("Final Office Action") for the reasons stated below.

SUMMARY OF THE INVENTION

The claims on appeal relate to roofing shingles provided with a release coating, and more specifically, to roofing shingles of which a pressure point portion of the bottom surface is provided with a release coating of a continuous film of particles.

The presently claimed invention avoids problems known in the art – specifically, distortion and localized sticking of shingles that are stacked together before installation on rooftops – by providing improved shingles that are coated at a pressure point portion of the bottom surface with a release coating containing particles that result in a film with poor interlaminar strength and good to perfect basal cleavage. These particles peel away from each other or are easily fractured, significantly reducing the force required to separate adjacent shingles from each other, and enabling easy separation.

EXAMINER'S ANSWER

Regarding the rejection of claims 1-3, 5-8 and 10 under 35 USC § 103(a), Appellants distinguished the cited references by arguing, *inter alia*, that none of the references taught or suggested the claim limitation that the application of the phyllosilicate be applied to the shingle's surface in a "non-reversible manner." With these words, the Appellants' intent was to distinguish the application of the phyllosilicate in the present claims from those in which a phyllosilicate is applied to a treated paper or polyester release material which is in turn adhered to a surface.

However, Examiner's response in the Answer is that "none of the pending claims require the phyllosilicate directly applied to the surface of the shingle in a non-reversible manner. . . ." and that such "non-reversible manner" language was not present in the claims.

Here, Appellants respectfully submit that the Examiner has misunderstood Appellants' argument,.

First, in the presently-claimed invention, **there is no treated paper or polyester release material**. Rather, there is a "release coating of a continuous film of particles having good to perfect basal cleavage" (claim 1). That is, this "release coating" is made up of the phyllosilicates themselves, disposed directly on the shingle. This is in contrast to the teachings of Algrim, which require a release material that is either paper or polyester, and that is treated (Algrim discusses several commercial suppliers of spray silicone and silicone-treated paper, at col. 5, lines 42-46).

Second, as used in the Appeal Brief, the term "non-reversible manner" as used by Appellants was intended to illustrate the contrast between applying the phyllosilicate particles "directly to the shingle" (Appeal Brief, page 14) versus applying them to a treated paper or polyester strip of release material which in turn is applied to the shingle – the intent being that in the former situation, once a phyllosilicate particle is applied to the shingle, it cannot be removed; but in the latter situation, the application is "reversible" – that is, it can be undone, because the treated paper or polyester release material can be removed from the shingle thereby removing all traces of phyllosilicate and restoring the shingle to its original state.

Thus, Applicants respectfully submit that the Examiner's response to Appellants' argument is not appropriate and further does not adequately refute Appellants' contention that the cited references do not teach each and every limitation of the pending claims.

Further, the Examiner stated in the Answer that "The Examiner is arguing that it would have been obvious to one of ordinary skill in the art at the time of the invention to *add the*

particles of Fasold to the release material of Algrim. . .” (Answer, page 7, emphasis in original). However, Appellants respectfully submit that because the release material of Algrim is a treated paper or polyester release material, even if a skilled artisan were motivated to combine those teachings with those of Fasold, the end result would not be the presently-claimed invention. Rather, it would be a shingle having thereon a strip of treated paper or polyester release material, with particles disposed thereon - not a shingle with a bottom surface “provided with a release coating of a continuous film of particles having good to perfect basal cleavage” as presently claimed (claim 1). Thus, there would be no expectation of success in such a combination.

For at least these reasons, and the reasons set forth in the prosecution history and Appeal Brief, Appellants respectfully submit that claims 1-3, 5-8 and 10 are patentable and not obvious in view of the combination of Algrim and Fasold, as evidenced by Wikipedia. Appellants further respectfully request that the Board consider, *inter alia*, the arguments made in this Reply before issuing its Decision.

If there is any fee due not already accounted for, please charge such fee to Deposit Account No. 03-1250.

Respectfully submitted,

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